

Attorney Docket No.: J6638(C)
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REPLY BRIEF

Under 37 C.F.R. §41.41

Sir:

In response to the Examiner's Answer mailed July 13, 2006, please enter the Reply Brief for Appellants concerning the above-identified application.

The Commissioner is hereby authorized to charge any additional fees, which may be required to our deposit account No. 12-1155, including all fees required under: 37 C.F.R. §1.16; 37 C.F.R. §1.17; 37 C.F.R. §1.18; 37 C.F.R. §1.136.

APPELLANTS' ARGUMENTS

This is in response to the Examiner's Answer mailed July 13, 2006.

With respect to the rejection of claims 1-5, 7-11, 13-19, 22 and 25-29, under 35 USC 103(a), as being unpatentable over Rath, et al., (US 5,972,322 of record), in view of Stewart (WO 98/30189), the Examiner asserts that Rath, et al., teaches a method for providing a customized cosmetic product consisting of combined separated components that are selected by the customer, wherein the separated components include a base composition and variable ingredients such as a thickener. Applicants agree with the Examiner's characterization of Rath insofar as the thickener is disclosed as being a component of the variable ingredients that may be added to the customized composition of Rath according to the user's selection. Since the present invention as currently claimed requires that the thickener (thickening composition) be a component of the inventive base composition, which is formulated at a location remote from the location that the customized personal care product is prepared in, Rath, by the Examiner's own admission fails to disclose or suggest the instant invention. Moreover, the claims on appeal explicitly exclude a thickener within the meaning of Rath, et al., from specifically defined performance agents to be selected by the consumer for customizing the product. The skilled person would not be motivated to combine Rath's thickener with the product base because Rath expressly teaches the thickener be added much later in the process to facilitate the thorough blending of the customizable components of Rath's customized cosmetic composition (see column 2, lines 8-12). Thus Rath, et al., neither discloses nor suggests and furthermore clearly teaches away from the instant invention as claimed.

Stewart teaches a computer controlled device for evaluating consumer test results and preferences (page 16, lines 10-20). Stewart disclose a wide range of additives that may be added to a particular formulation. However, Stewart is silent about how each additive relates to the other, with respect to any ingredients that may be in common with each other. Therefore, Stewart fails to disclose or suggest that the vehicle of each additive have at least two ingredients in common, which is required by the instant claims. Absent impermissible hindsight, the skilled person would not combine Rath, et al., with Stewart because Rath teaches away from presenting the thickener as a component of the product base which is formulated at a location remote from the location where a customized personal care product is prepared (see

instant independent claim 1), and Stewart does not remedy the deficiencies of Rath, et al., with respect to disclosing or suggesting the instant invention as presently claimed.

The examiner asserts that the appellant's arguments of whether the thickener should be considered as a variant or base ingredient in the claimed invention and/or if the cited references are irrelevant to the patentability of the instant application in view of the totality of the cited references. Applicant's respectfully disagree with the Examiner's characterizations of the relevance of the thickener because the inventors, being their own lexicographers of their invention, specifically define that thickening agents are a part of the base composition (see page 4, line 30 to page 5, line 10) and as stated in this passage must be added to the base composition at a location that is different than where the performance agents are added (i.e., where the customized product is prepared).

The examiner asserts that the fact that Stewart do not teach expressly the variants having at least two ingredients in common as being an obvious limitation to one of ordinary skill in the art. Moreover, the examiner cites the examples of Rath, et al., and Stewart for the proposition that concentrates may obviously have several ingredients in common. Contrary to the examiner's assertion, it is well settled that the examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the applicant's invention. Rather, the examiner has the burden to show some teaching or suggestion in the references to support the use in the particular claim combination. (See SmithKlein Diagnostics, Inc., v. Helena Laboratories Corp., 8 USPQ2D 1468 (Fed. Circ. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new system, does not necessarily render such a system obvious unless the art also contains something to suggest the desirability of the proposed combination, i.e., the motivation to combine the references. In re: Grabiak, 226 USPQ 870,872 (Fed. Cir. 1985). The fact that Rath, et al., teaches that the thickener must be applied separately from the base composition would not lead one of ordinary skill to use the opposite configuration and require that the thickener be a part of the base composition. Therefore, there would be no motivation to combine Rath, et al., with Stewart to derive the instant invention as presently claimed due to the contrary teaching of Rath, et al., with respect to how a thickener is introduced into the customized personal care product.

With respect to the rejection of claims 6, 20 and 21 under 35 U.S.C. 103(a), as being unpatentable over Rath, et al., in view of Stewart and in further view of Rigg, et al. (US 5,622,692), the examiner asserts that it would be obvious to combine Rigg's bar code label for identifying the customized composition. Applicant's respectfully submit that Rigg, et al., doesn't remedy the deficiencies of Rath, et al., in view of Stewart as claims 6, 20 and 21 contain all of the limitations of independent claim 1. Although Rigg, et al., discloses a method and apparatus for customizing facial foundation products where a wide range of additives may be added to a particular foundation; Rigg, et al., is silent about how each additive relates to each other with respect to any ingredients that may be in common with each other as required by claims 6, 20 and 21 by virtue of their dependency on claim 1 or of claims that depend from claim 1.

In view of the above, appellant's respectfully submit that proper rejections under 35 U.S.C. §103 have not been made. Accordingly, reversal of the final rejection by the honorable board is appropriate and is courteously solicited.

Respectfully submitted,



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